

Application No.: 09/755,355

Atty Docket: BLFR 1002-1

REMARKS

In response to the restriction requirement dated 01 September 2005, Applicants have elected with traverse **Group I** (claims 1-15 and 39-42, directed to supplying sales history to a good that lacks a sales history by associating the sales data of another good). Applicants withdraw **Group II** (claims 16-38, directed to supplying a sales history to a selling location by associating sales history from a cloned location).

Statement of Substance of Interview

A telephonic interview was held with Examiner van Doren on 19 August 2005, to discuss a mistaken notice of abandonment, which was rescinded. The substance of the claims was not discussed.

TRAVERSAL OF RESTRICTION

In this section, we review the new rules regarding restriction and then show how searches required for claims 1-15 and 39-42 encompass all of the elements to be searched for independent claim 16.

The new revision of the MPEP, published August 2005, is much clearer on the limits on an Examiner's discretion to impose restriction requirements than the prior MPEP. In particular, §§ 803 *et seq.* set standards that the Examiner may not have been aware of at the time of the restriction requirement, as she did not reference them.

802.01 Meaning of "Independent" and "Distinct" [R-3]**II. < DISTINCT**

****>**Two or more inventions are related (i.e., not independent) if they are disclosed as connected in at least one of design (e.g., structure or method of manufacture), operation (e.g., function or method of use), or effect. Examples of related inventions include< combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc. ****>**In< this definition the term related is used as an alternative for dependent in referring to ***>**inventions< other than independent ***>**inventions<.

>Related inventions are distinct if the inventions as claimed are not connected in at least one of design, operation, or effect (e.g., can be made by, or used in, a materially different process) and wherein at **least one invention is PATENTABLE** (novel and nonobvious) **OVER THE OTHER** (though they may each be unpatentable over the prior art). See MPEP § 806.05(c) (**combination and subcombination**) and § 806.05(j) (related products or related processes) for examples of when a **two-way test** is

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required for distinctness.<

803 Restriction — When Proper [R-3]

Under the statute>, the claims of< an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 802.01, § 806.06, and § 808.01<) or distinct (MPEP § 806.05 - § 806.05(j)<). If the search and examination of >all the claims in an< application can be made **without serious burden**, the examiner **must** examine >them< on the merits, even though >they include< claims to independent or distinct inventions. >

I. < CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent (see MPEP § 802.01, § 806.06<, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(j)<); and
- (B) There >would< be a **serious burden** on the examiner if restriction is >not< required (see MPEP § 803.02, >§ 808<, and § 808.02).

For purposes of the initial requirement, a **serious burden** on the examiner may be *prima facie* shown ** by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02. That *prima facie* showing may be **rebutted by appropriate showings** or evidence by the applicant. Insofar as the criteria for restriction practice relating to Markush-type claims is concerned, the criteria is set forth in MPEP § 803.02. Insofar as the criteria for restriction or election practice relating to claims to genus-species, see MPEP § 806.04< - § 806.04(i) and § 808.01(a).

806.05(c) Criteria of Distinctness > Between< Combination >and< Subcombination ** [R-3]

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To support a requirement for restriction >between combination and subcombination inventions<, **both two-way distinctness and reasons for insisting on restriction** are necessary, i.e., >there would be a **serious search burden** as evidenced by< separate classification, status, or field of search. See MPEP § 808.02.

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I. SUBCOMBINATION ESSENTIAL TO COMBINATION***AB_{sp}/B_{sp} No Restriction***

Where a combination as claimed sets forth the details of the subcombination as separately claimed, there is no evidence that combination AB_{sp} is patentable without the details of B_{sp}. The inventions are not distinct and a requirement for restriction must not be made or maintained, even if the subcombination has separate utility. This situation can be diagrammed as combination AB_{sp} ("sp" is an abbreviation for "specific"), and subcombination B_{sp}. Thus the specific characteristics required by the subcombination claim B_{sp} are also required by the combination claim.

(the "***" notations are from the MPEP text; the "** * *" notations are added to indicate omitted sections). The final section, "subcombination essential to combination" is added in this revision and of particular interest in this response.

The Examiner has not shown either two way distinctness or a serious burden of searching. There is no two way distinctness, because all of the elements of claim 1 are found in claim 36 and all of the elements of claim 64 are found in claim 37, which depends from claim 36. As the Examiner has not made any assertion of two-way distinctness, the restriction requirement does not satisfy the applicable provisions of the MPEP. It would not be proper to enter a final restriction requirement at this time.

There is no serious burden to examining claim 16 at the same time as claims 1-15 and 39-42. First, all of the claims already have been searched. Second, this is one of five applications on this Examiner's docket that are closely related. Thus far, the Examiner has applied the same art in each of the related cases that she is examining.

Third, it is difficult to imagine that the Examiner would find different art to apply to claim 1 than to claim 16. In the first office action, the Examiner's analysis of claim 1 was cut and pasted into a response to claim 16, without any difference in cited material or in words used to apply the cited material:

3. As per claim 1, Technology Strategy, Inc. teaches a computer implemented method of supplying a sales history for a good lacking a sales history, including:

associating sales history data for sales of a cloned good at a plurality of selling locations with an other good (See at least reference B, page 1, section 3, page 2, sections 1-2, page 3, sections 2-5, reference C, page 3, sections 4-6, wherein sales history data is associated); ...

8. As per claim 16, Technology Strategy, Inc. discloses a computer

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implemented method of supplying a sales history for a selling location lacking a sales history, including:

associating sales history data for sales of a plurality of goods at a cloned selling location with an other selling location (See at least reference B, page 1, section 3, page 2, sections 1-2, page 3, sections 2-5, reference C, page 3, sections 4-6, wherein sales history data is associated); ...

Office Action mailed Dec. 10, 2004, pp. 2-3. The Examiner's *prima facie* assertion of burden is accordingly overcome.

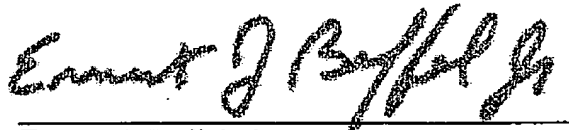
These claims are not so difficult to examine or so dissimilar that any restriction requirement should be imposed.

CONCLUSION

Applicants respectfully submit that the pending claims are now in condition for allowance and thereby solicit acceptance of the claims, in light of these amendments.

The undersigned can ordinarily be reached at his office at (650) 712-0340 from 8:30 a.m. to 5:30 p.m. PST, Monday through Friday, and can be reached at his cell phone at (415) 902-6112 most other times.

Respectfully submitted,



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